

REMARKS

This Amendment is responsive to the Office Action mailed January 26, 2006, ("Office Action").

Election/Restriction

In the Election mailed April 20, 2005, Applicants elected with traverse group II, identified by the Office as claims 9-21. The Examiner maintained the Restriction requirement. Claims 1-8 have been withdrawn.

In the Election mailed July 13, 2005, Applicant elected with traverse species 2-a. Upon further consideration, the Examiner incorporated the examination of species a-1 and a-2 into grouping II.

Claim Rejections – 35 USC § 103

Claims 9-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nakagawa et al. (US 6,024,774)("Nakagawa") considered with Clawson (US 6,641,625)("Clawson").

Nakagawa is relied on by the Office as teaching an apparatus for selectively reducing carbon monoxide content of a hydrogen rich gas, comprising: a catalyst bed containing an oxidation catalyst; a porous tube positioned substantially within a catalyst bed for distributing raw material gas throughout the catalyst bed; and a cooling jacket for maintaining the reactor temperature; and the porous tube is an alumina tube.

The reliance on Nakagawa is misplaced. The Nakagawa invention is not directed to an apparatus for selectively reducing carbon monoxide content of a hydrogen rich gas. The object of the Nakagawa invention is to provide a chemical reaction apparatus capable of enhancing the generation rate for the main product gas by removing carbon dioxide as a byproduct gas out of the reaction system (Col. 1, lines 43-46).

As demonstrated throughout the specification, the present invention is generally directed to an apparatus for selectively reducing carbon monoxide content of a hydrogen rich gas (0011, lines 1-3; 0038, lines 1-5; 0039, lines 1-4). Further, the preamble of independent claims 9 and 16 contain the following expression: “for selectively reducing the carbon monoxide content of a hydrogen rich gas.”

Despite these differences between the present invention and Nakagawa, the Examiner asserts the present invention is unpatentable over Nakagawa. The Examiner asserts that expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. Further, the Examiner asserts that an apparatus must be distinguished from the prior art in terms of structure rather than function.

“The effect preamble language should be given can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” *Corning Glass Works v. Sumitomo Elec. U.S.A. Inc.*, 868 F.2d 1251, 9 U.S.P.Q. 2d 1962, 1966 (Fed. Cir. 1989). An examination of the specification clearly reveals that the expression “for selectively reducing the carbon monoxide content of a hydrogen rich gas” in the preamble of independent claims 9 and 16 is not mere introductory language. See *In re Stencel*, 828 F.2d 751, 754, 4 U.S.P.Q. 2d 1071, 1073 (Fed. Cir. 1987). Rather, the language was clearly intended to represent an additional structural limitation. Throughout the specification, the invention is only discussed relative to “selectively reducing the carbon monoxide content of a hydrogen rich gas.” “[W]hen the claim drafter chooses to use *both* the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.” *Bell Communications Research v. Vitalink Communications Corp.*, 55 F.3d 615, 34 U.S.P.Q. 2d 1816, 1820 (Fed. Cir. 1995) (emphasis in original). In this case, *both* the preamble and the body of the claims define the subject matter of the invention.

The expression “for selectively reducing the carbon monoxide content of a hydrogen rich gas” in the preamble of independent claims 9 and 16 clearly is an

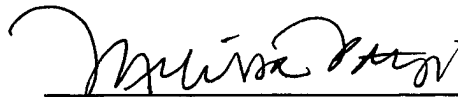
additional structural limitation and thus, independent claims 9 and 16, as well as the claims which depend from them directly or indirectly, are not unpatentable over Nakagawa.

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Applicants respectfully request reconsideration of the obviousness rejection. This is believed to be a full and complete response to the outstanding Office Action mailed January 26, 2006. The present application is believed to be in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of the captioned application is respectfully requested.

Respectfully submitted,



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April 24, 2006
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